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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,061	06/18/2001	Izumi Takemoto	P66783US0	1762
136	7590	04/20/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			BOYD, JENNIFER A	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,061

Applicant(s)

TAKEMOTO, IZUMI

Examiner

Jennifer A Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 8-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 8-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1 page.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 19, 2004 has been entered. The Applicant's Amendments and Accompanying Remarks, filed February 19, 2004, have been entered and have been carefully considered. Claim 1 is amended, claims 3 – 7 are cancelled, claims 8 – 18 are added, and claims 1 – 2 and 8 – 18 are pending. In view of Applicant's Amendments, the Examiner withdraws all rejections as detailed in paragraph 3 of the previous Office Action dated October 15, 2003. However, after an updated search, the invention as currently claimed is found to be unpatentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 8 – 10, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Claims 2 and 14 are rejected as being dependent on rejected claims.

5. Claims 1, 8 – 10, 13 and 15 are unclear because the contents of the claim preambles do not appear to be consistent with the contents of the claims. For instance in claim 1, the preamble states a “fabric woven from *noble* metal filament” but the body of the claim requires “a gold *alloy* metal monofilament”. The Examiner will assume that the Applicant only requires that the woven fabric comprise a gold alloy metal monofilament.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

7. Claims 1 – 2, 8 and 11 - 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Labarte et al. (US 3,686,734) in view of Ogasa (US 6,077,366).

Labarte is directed to a method of making jewelry from precious metals and their alloys (Abstract).

As to claims 1, Labarte teaches a loosely woven metal mesh (Abstract) comprising wires of gold alloy (column 2, lines 30 – 40).

As to claims 11 and 13, it should be noted that the Examiner has given no patentable weight to “an article of apparel”. Furthermore, it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte*

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Masham, 2 USPQ2d 1647 (1987). Labarte teaches a loosely woven metal mesh (Abstract) comprising wires of gold alloy (column 2, lines 30 – 40).

As to claims 15 and 17, it should be noted that the Examiner has given no patentable weight to “an article of garniture”. Furthermore, it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Labarte teaches a loosely woven metal mesh (Abstract) comprising wires of gold alloy (column 2, lines 30 – 40).

As to claims 1, 12, 14, 16 and 18, Labarte fails to teach the composition of the gold alloy as containing at least 99.7% gold and a trace of an element chosen from the group consisting of gadolinium and calcium.

Ogasa is directed to a process for producing high-purity hard gold alloys (Title). Ogasa teaches a high-purity gold comprising a gold content of at least 99.7% or more by weight and containing 50 ppm or more of Gd (gadolinium) (column 2, lines 30 – 60). The Examiner equates containing 50 ppm or more of Gd to having a “trace of an element”. Ogasa notes that the high-purity gold retains a high-quality look for a long period of time (column 1, lines 48 – 60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the woven metal mesh of Labarte comprising the gold alloy of Ogasa motivated by the desire to create a piece of jewelry which retains a high-quality look for long period of time.

As to claims 1, 8, 11, 13, 15 and 17, Labarte in view of Ogasa discloses the claimed invention except for that the gold alloy monofilament has a diameter of 70 micrometers or less as required by claims 1, 11 and 15 or a diameter between 30 and 70 micrometers as required by claims 8, 13 and 17. It should be noted that the diameter is a result effective variable. For example, as the diameter increases, the monofilament increases in strength but if the diameter is too large, the resulting fabric loses elasticity and exhibits poor drape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create the monofilament with a diameter of 70 micrometers or less as required by claims 1, 11 and 15 or a diameter between 30 and 70 micrometers as required by claims 8, 13 and 17, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to optimize the diameter of the monofilament to create a fabric with good drapability while maintaining its strength.

As to claims 1, 2, 11 and 15, although Labarte in view of Ogasa does not explicitly teach that the claimed monofilament tensile strength is 0.12 to 6.5 N as required by claims 1, 11 and 15 and the monofilament elongation is 1.5% or more as required by claim 2, it is reasonable to presume that monofilament tensile strength is 0.12 to 6.5N as required by claims 1, 11 and 15 and the monofilament elongation is 1.5% or more as required by claim 2 is inherent to Labarte in view of Ogasa. Support for said presumption is found in the use of like materials (i.e. a gold alloy monofilament with a diameter of 70 micrometers or less), which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of would obviously have been present

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once the Labarte in view of Ogasa product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

8. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akio (US 2002/0104671 A1).

Akio is directed to a substrate comprising conductive filaments 20 and insulative filaments 24 (page 3, [0047]) which are woven together (page 4, [0048]). Akio teaches that the insulative filaments are used as the warp threads and the conductive filaments are used as the weft threads (page 4, [0048] and [0058]). Akio teaches that the warp threads can be made of glass and the weft threads can be made of gold alloys (page 4, [0048] and [0058]). It should be noted that the material of the weft and warp are different.

Akio discloses the claimed invention except for that the gold alloy monofilament has a diameter of 70 micrometers or less as required by claim 9 or a diameter between 30 and 70 micrometers as required by claim 10. It should be noted that the diameter is a result effective variable. For example, as the diameter increases, the monofilament increases in strength but if the diameter is too large, the resulting fabric loses elasticity and exhibits poor drape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create the gold alloy monofilament has a diameter of 70 micrometers or less as required by claim 9 or a diameter between 30 and 70 micrometers as required by claim 10, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one

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would have been motivated to optimize the diameter of the monofilament to create a fabric with good drapability while maintaining its strength.

Akio does not explicitly teach that the claimed monofilament tensile strength is 0.12 to 6.5 N as required by claim 9, it is reasonable to presume that monofilament tensile strength is 0.12 to 6.5 N as required by claim 9 is inherent to Akio. Support for said presumption is found in the use of like materials (i.e. a gold alloy monofilament with a diameter of 70 micrometers or less), which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of would obviously have been present once the Akio product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

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Response to Arguments

9. Applicant's arguments with respect to claims 1 – 2 and 8 – 18 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Boyd

April 12, 2004



Ula C. Ruddock

Primary Examiner
Tech Center 1700